

DELIVERED BY HAND ON MAY 5, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Hong JIN *et al.*

Application No.: 09/161,122

Filed: September 25, 1998

For: RECOMBINANT RSV EXPRESSION
SYSTEMS AND VACCINES



Group Art Unit: 1643

Examiner: B. Brumback

Attorney Docket No.: 7682-045

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**REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT WITH
PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Restriction Requirement dated November 17, 1999, please consider the following traversal and provisional election.

A Petition for the Extension of Time under 37 C.F.R. § 1.136(a) for a period of five months from December 17, 2000, is included herewith. It is not believed that any further extensions of time claims are available. However, if additional extensions of time are available to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required are hereby authorized to be charged to PENNIE & EDMONDS LLP. Deposit Account No. 16-1150.

With respect to Examiner's division of the invention into nine groups and the reasons stated therefor, Applicant respectfully traverses.

The Examiner contends that each group of claims is directed to an invention that is distinct from the other. This contention has two bases. First, the Examiner contends that the allegedly different inventions are patentably distinct products having different and distinct structures and functions. Furthermore, the Examiner contends that the allegedly different classification of the nine different groups justifies the restriction requirement. Restriction Requirement, at page 4. Applicant respectfully submits that the classification as presently set forth in the Restriction Requirement would not justify a restriction requirement between the nine aforementioned Groups.

Specifically, for example, the Examiner asserts that the claims of Group II ("Claims 2, 18, and 13 to the extent that it reads on claim 18, drawn to an isolated infectious RSV particle comprising a chimeric genome or antigenome encoding antigenic polypeptides of both RSV-A and

RSV-B, to a vaccine comprising the particle") are classified in class 424, subclass 199.1; that the claims of Group IV ("Claims 4, 5, claims 1-3 to the extent that they read on claims 4 and 5, claims 19, 20, and 13 to the extent that it reads on claims 19 and 20, drawn to an isolated infectious RSV particle comprising a heterologous sequence and to vaccines comprising chimeric RSV with a heterologous gene") are classified in class 424, subclass 199.1; that the claims of Group VII ("Claim 14, drawn to a vaccine comprising a chimeric RSV with a mutated SH gene") are classified in class 514, subclass 44; and that the claims of Group VIII ("Claim 16, drawn to a vaccine comprising a chimeric RSV with a mutated NS1 gene and to claim 13 to the extent that it reads on claim 14") are classified in class 424, subclass 199.1.

Applicant respectfully submits that Class 424 is entitled "Drug, Bio-affecting and Body Treating Compositions." Subclass 199.1 is entitled "Recombinant virus encoding one or more heterologous proteins or fragments thereof."

Thus, Class 424, subclass 199.1 covers Recombinant virus encoding one or more heterologous proteins or fragments thereof. Therefore, Applicant respectfully submits that the classification system of the U.S. Patent and Trademark Office unambiguously supports the examination of the products of Groups II, IV, VII, and VIII, as characterized by the Examiner, in one application.

Applicant respectfully submits that subject matters of the claims divided by the Examiner into Groups I, II, III, IV, V, VI, VII, VIII and IX do not justify a restriction requirement into the nine afore-mentioned groups, based on the reasons set forth by the Examiner. Indeed, the classification system of the U.S. Patent and Trademark Office clearly demonstrates that all of claims Groups II, IV, VII and VIII should indeed be examined together in the instant application.

Moreover, were Applicant to elect Group II, the required search would necessarily encompass that for the subject matter of Groups IV, VII and VIII.

The M.P.E.P. § 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions (emphasis added).

Thus, in view of M.P.E.P. § 803, all the subject matter in Groups II, IV, VII and VIII should be examined together. Even if the subject matter of these groups are distinct inventions, it would not be a "serious burden" on the Examiner to search these groups in this application. Indeed, as Applicant has explained above, the burden of searching these two groups together would be no greater than that for Group IV alone.

In view of the above remarks, it is believed that the undersigned has shown that the inventions of Groups II, IV, VII, and VIII are not distinct as required by M.P.E.P. § 803. Thus,

Applicant has demonstrated at the very least that the subject matter of the claims of Groups II (Claims 2, 18, and 13 to the extent that it reads on claim 18), IV (Claims 4, 5, claims 1-3 to the extent that they read on claims 4 and 5, claims 19, 20, and 13 to the extent that it reads on claims 19 and 20), VII (Claim 14), and VIII (Claim 16) should be examined in the same application. Applicant respectfully requests, therefore, that the restriction requirement be modified and that all of Claims 1-5, 13, 14, 16, and 18 be searched and examined together.

In order to be fully responsive, Applicant hereby provisionally elects the claims of Group II (claims 2, 18, and 13 to the extent that it reads on claim 18) in accordance with 37 C.F.R. § 1.143. Applicant reserves the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Should the Examiner deem that the arguments set forth are not persuasive enough to overcome the need for the restriction requirement, then a personal or telephonic interview is respectfully requested.

Respectfully submitted,

Date

May 5, 2000


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